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ART UNIT	**PAPER NUMBER**
2171	6

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/941,072	GOODMAN ET AL.	
	Examiner	Art Unit	
	Etienne P LeRoux	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 March 2004* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, 7-10, 12-16, 19-24, 26-29, 31-33, 35, 36 and 39-41 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,408,301 issued to Patton et al (hereafter Patton '301).

Claims 1 and 40:

Patton '301 discloses:

a) determining whether or not the storage medium has been considered before [col 3, lines 53-61]

b) if the storage medium has not been considered before, then

(i) determining a unique label identifier [picture index per col 3, line 61]

(ii) determining a unique volume label [disc ID per col 5, lines 1-8]

(iii) writing the unique volume label onto the storage medium [Picons, Fig 1, item 23 and col 4, lines 10-20]

(iv) providing a command to generate a label based on the unique label identifier, the label to be associated with the storage medium [touch screen operation controls 24 per Fig 1, touch screen indexing controls 26 per Fig 1, record/capture 28 per Fig 1]

c) updating a database based on files added to or deleted from the storage medium [col 4, lines 10-19] .

Claim 2:

Patton '301 discloses d) synchronizing the database with a database on a device apart from the read/write machine [GPS per col 4, line 29].

Claim 5:

Patton '301 discloses a DVD drive [col 3, lines 53-63].

Claim 7:

Patton '301 discloses wherein the act of determining a unique volume label is based, at least in part, on state information accessible to the read/write machine [col 4, lines 10-19].

Claim 8:

Patton '301 discloses wherein the state information is a count sequence [col 4, line 37].

Claim 9:

Patton '301 discloses wherein the database includes records, each record including a first field having a value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium [disk ID per col 5, line 5, and Fig 1 item 23].

Claim 10:

Patton '301 discloses:

a) accepting information read from a label associated with the storage medium [col 5, lines 6-8];

b) converting the accepted information into a database key [col 5, lines 6-8];

c) requesting records from a database instance using the database key [col 4, lines 3-6];

d) accepting records in response to the request [col 4, lines 3-6]; and

e) rendering information about the accepted records [col 4, lines 3-6].

Claim 12:

Patton '301 discloses wherein the information about the accepted records rendered includes file names [Fig 6, item 74 and col 5, line 66].

Claim 13:

Patton '301 discloses wherein the accepted information read from a label associated with the storage medium is read by a handheld device, and the information about the accepted records is rendered on the handheld device [Fig 1, item 10].

Claim 14:

Patton '301 discloses wherein the read label is converted into a database key by the handheld device, the records are requested from a database instance using the database key by the handheld device, and the records are accepted in response to the request by the handheld

device [col 5, lines 6-8] .

Claim 15:

Patton '301 discloses:

a) accepting one or more search parameters [col 5, line 62 through col 6, line 8];

b) generating a query based on the search parameters [col 5, line 62 through col 6, line 8];

c) accepting one or more records returned in response to the query generated [Fig 7 and col 6, lines 9-15];

d) rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted [Fig 7 and col 6, lines 9-15].

Claim 16:

Patton '301 discloses:

e) accepting information read from the machine-readable labels [col 5, lines 1-8];

f) if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans [Fig 7 and col 6, lines 9-15].

Claim 19:

Patton '301 discloses wherein each of the labels include human-readable part, and wherein the information associated with each of the one or more records accepted corresponds to the human-readable part of the labels [Fig 1, item 23 and col 4, lines 10-20].

Claims 20 and 41:

Patton '301 discloses:

a) means for reading files from and/or writing files to a removable storage medium;

b) means for generating a label;

c) means for determining whether or not the removable storage medium has been considered before [col 3, lines 53-61];

d) means, if the storage medium has not been considered before, for

(i) determining a unique label identifier [picture index per col 3, line 61],

(ii) determining a unique volume label [picons, Fig 1, item 23 and col 4, lines 10-20],

(iii) instructing the means for reading and/or writing files to write the unique volume label onto the storage medium [col 5, lines 7-8], and

(iv) providing a command to generate a label based on the unique label identifier, to the means for generating a label [touch screen operation controls 24 per Fig 1, touch screen indexing controls 26 per Fig 1, record/capture 28 per Fig 1]; and

e) a database, wherein the database is updated based on files added to or deleted from the removable storage medium [col 4, lines 10-19].

Claim 21:

Patton '301 discloses means for synchronizing the database with a database on a device apart from the apparatus [GPS per col 4, line 29].

Claim 22:

Patton '301 discloses wherein the device is a handheld device [Fig 1, item 10].

Claim 23:

Patton '301 discloses wherein the device is an untethered, handheld device [Fig 1, item 10].

Claim 24:

Patton '301 discloses wherein the means for reading files from and/or writing files to a removable storage medium is a DVD drive [col 3, lines 53-63].

Claim 26:

Patton '301 discloses wherein the unique volume label is determined, at least in part, based on the state information [col 4, lines 10-19].

Claim 27:

Patton '301 discloses wherein the state information is a count sequence [col 4, line 37].

Claim 28:

Patton '301 discloses wherein the database includes records, each record including a first field having a value associated with the unique volume label, and a second field having a value associated with a file stored on the removable storage medium [col 5, lines 1-8]

Claim 29:

Patton '301 discloses:

a) means for reading a label associated with the storage medium [picons, Fig 1, item 23 and col 4, lines 10-20];

b) means for accepting information read, by the means for reading, from a label associated with the storage medium [col 4, lines 10-20];

c) means for converting the read label into a database key [col 5, lines 6-8];

d) means for requesting records from a database instance using the database key [col 4, lines 3-6];

d) means for accepting records in response to the request [col 4, lines 3-6]; and

e) means for rendering information about the accepted records [col 4, lines 3-6].

Claim 31:

Patton '301 discloses wherein the information about the accepted records rendered includes file names [Fig 6, item 74 and col 5, line 66].

Claim 32:

Patton '301 discloses wherein the means for rendering is a display [col 4, lines 3-6].

Claim 33:

Patton '301 discloses further comprising: f) the database [col 4, line 66 through col 5, line 8].

Claim 35:

Patton '301 discloses:

a) a user input for accepting one or more search parameters [col 5, line 62 through col 6, line 8];

b) means for generating a query based on the accepted one or more search parameters [col 5, line 62 through col 6, line 8];

c) means for accepting one or more records returned in response to the query generated [Fig 7 and col 6, lines 9-15];

d) means for rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted [Fig 7 and col 6, lines 9-15].

Claim 36:

Patton '301 discloses:

e) a label reader for reading information read from the machine-readable labels [col 5, lines 1-8]

f) an output means for generating a first indicator able to be perceived by humans if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted [Fig 7, and col 6, lines 9-15].

Claim 39:

Patton '301 discloses wherein each of the labels include human-readable part, and wherein the information associated with each of the one or more records accepted corresponds to the human-readable part of the labels [Fig 1, item 23 and col 4, lines 10-20].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6, 11, 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton '301

Claim 6:

Patton '301 discloses the elements of claim 1 as noted above.

Patton '301 fails to disclose a bar code label.

Official Notice is taken that a bar code label is well-known and expected in the art.

The ordinarily skilled artisan would have been motivated to modify Patton '301 to include a bar code label for the purpose of providing a means for automatic entry of information via a handheld scanner.

Claim 11:

Patton '301 discloses the elements of claim 1 as noted above.

Patton '301 fails to disclose a bar code scanner.

Official Notice is taken that a bar code scanner is well-known and expected in the art.

The ordinarily skilled artisan would have been motivated to modify Patton '301 to include a bar code scanner for the purpose of providing a means for automatic entry of information via a handheld device.

Claim 25:

Patton '301 discloses the elements of claim 1 as noted above.

Patton '301 fails to disclose a bar code label.

Official Notice is taken that a bar code label is well-known and expected in the art.

The ordinarily skilled artisan would have been motivated to modify Patton '301 to include a bar code label for the purpose of providing a means for automatic entry of information via a handheld scanner.

Claim 30:

Patton '301 discloses the elements of claim 1 as noted above.

Patton '301 fails to disclose a bar code label.

Official Notice is taken that a bar code label is well-known and expected in the art.

The ordinarily skilled artisan would have been motivated to modify Patton '301 to include a bar code label for the purpose of providing a means for automatic entry of information via a handheld scanner.

Claims 3, 4 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton '301 in view of Pub No US 2003/0161614 issued to Yanagihara et al (hereafter Yanagihara '614).

Claim 3:

Patton '301 discloses the elements of claims 1 and 2 as noted above.

Furthermore, Patton '301 discloses a handheld device [Fig 1, item 10].

Patton '301 fails to disclose wherein the read/write machine is a personal computer.

Yanagihara '614 discloses wherein the read/write machine is a personal computer [Fig 1, item 16]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Patton '301 to include wherein the read/write machine is a personal computer as taught by Yanagihara '614.

The ordinarily skilled artisan would have been motivated to modify Patton '301 per the above for the purpose of providing a convenient means for editing, displaying and transmitting the images over the Internet.

Claim 4:

Patton '301 discloses wherein the device is an untethered handheld device [Fig 1, item 10].

Claim 34:

Patton '301 discloses the elements of claims 29 and 33 as noted above.

Patton '301 fails to disclose means for synchronizing the database with a database maintained by a separate machine which created the storage medium.

Yanagihara '614 discloses means for synchronizing the database with a database maintained by a separate machine which created the storage medium [Fig 1, item 16].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Patton '301 to include means for synchronizing the database with a database maintained by a separate machine which created the storage medium as taught by Yanagihara '614.

The ordinarily skilled artisan would have been motivated to modify Patton '301 per the above for the purpose of providing a convenient means for editing, displaying and transmitting the images over the Internet.

Claims 17, 18, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton '301 in view of Pub No US 2001/0018356 Cathey et al (hereafter Cathey '356)

Claim 17:

Patton '301 discloses the elements of claims 15 and 16 as noted above.

Patton '301 fails to disclose if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans.

Cathey '356 discloses if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans [paragraph 10].

It would have been obvious to one of ordinary skill I the art at the time the invention was made to modify Patton '301 to include if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans as taught by Cathey '356.

The ordinarily skilled artisan would have been motivated to modify Patton '301 per the above for the purpose of providing a means to ensure reliable data transfer by avoiding low power conditions.

Claim 18:

The combination of Patton '301 and Cathey '356 discloses the elements of claims 15-17 as noted above.

The combination of Patton '301 and Cathey '356 fails to disclose wherein the first indicator is a first audible sound, and the second indicator is a second audible sound.

However, Cathey '356 discloses a first audible indicator paragraph 10].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Patton '301 and Cathey '356 to include wherein the first indicator is a first audible sound, and the second indicator is a second audible sound.

The ordinarily skilled artisan would have been motivated to modify the combination of Patton '301 and Cathey '356 per the above for the purpose of providing a low-power alarm for the high-power consumption devices and a low-power alarm for the low-power consumption devices.

Claim 37:

Patton '301 discloses the elements of claims 35 and 36 as noted above.

Patton '301 fails to disclose if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans.

Cathey '356 discloses if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans [paragraph 10].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Patton '301 to include if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans as taught by Cathey '356.

The ordinarily skilled artisan would have been motivated to modify Patton '301 per the above for the purpose of providing a means to ensure reliable data transfer by avoiding low power conditions.

Claim 38:

The combination of Patton '301 and Cathey '356 discloses the elements of claims 35-37 as noted above.

The combination of Patton '301 and Cathey '356 fails to disclose wherein the first indicator is a first audible sound, and the second indicator is a second audible sound.

However, Cathey '356 discloses a first audible indicator paragraph 10].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Patton '301 and Cathey '356 to include wherein the first indicator is a first audible sound, and the second indicator is a second audible sound.

The ordinarily skilled artisan would have been motivated to modify the combination of Patton '301 and Cathey '356 per the above for the purpose of providing a low-power alarm for the high-power consumption devices and a low-power alarm for the low-power consumption devices.

Response to Arguments

Applicant's arguments filed 3/4/2004 have been fully considered but they are not persuasive.

First Applicant Argument:

Applicant states in the second paragraph on page 16 "Independent claims 1 and 20 are not anticipated by the Patton patent because the Patton patent does not describe (means for) determining whether or not a storage medium has been assigned a unique label identifier."

First Examiner Response:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., (means for) determining whether or not a storage medium has been assigned a unique label identifier) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second Applicant Argument:

Applicant states in the second paragraph on page 16 "and if not, determining a unique label identifier for the storage medium and providing a command to generate a label."

Second Examiner Response:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., and if not, determining a unique label identifier for the storage medium and providing a command to generate a label) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Third Applicant Argument:

Applicant states in the second paragraph on page 17 "Although picons are stored on the storage medium of the Patton patent, they are not generated 'if the storage medium has not been assigned a unique volume label and a unique label identifier.'

Third Examiner Response:

Examiner is not persuaded.

Third Examiner Response:

Examiner is not persuaded. Consider the following excerpt from the MPEP:

MPEP § 2106. II.C Review the Claims:

> Office personnel must rely on the applicant's disclosure to properly determine the meaning of terms used in the claims. *Markman v. Westview Instruments,* 52F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd,* U.S. 116 S. Ct. 1384 (1996). An applicant is entitled to be his or her own lexicographer, and in many instances will provide an explicit definition for certain terms used in the claims. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.,* 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings.").
>
> Office personnel must always remember to use the perspective of one of ordinary skill in the art. Claims and disclosures are not to be evaluated in a vacuum. If elements of an invention are well-known in the art, the applicant does not have to provide a disclosure that describes those elements. In such a case the elements will be construed as encompassing any and every art-recognized hardware or combination of hardware and software technique for implementing the defined requisite functionalities.
>
> Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris,* 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater,* 415F.2d 1393, 1404-05, 162 USPAQ 541, 550-

> 551 (CCPA 1969). See also *In re Zletz,* 893 F.2d 319, 321-22, 13 USPQ2d 13201322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonable allow ....

Applicant does not particularly point to the specification for an explicit definition of the term "unique label identifier." Examiner will thus give supra claim limitation its broadest reasonable interpretation. Examiner maintains the picture index per column 3, line 61 of the teaching of Patton reads on the claimed "unique label identifier." Furthermore, examiner maintains that in the disclosure of Patton "if the storage medium has not been assigned a unique volume label is inherent. There is absolutely nothing in the disclosure of Patton that duplicate volume labels are created.

Fourth Applicant Argument:

Applicant states in the third paragraph on page 17 "Database synchronization is understood by those skilled in the art as making one instance of a database conform to another instance of the database."

Fourth Examiner Response:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Database synchronization is understood by those skilled in the art as making one instance of a database conform to another instance of the database) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Fifth Applicant Argument:

Applicant states in the third paragraph on page 18 "Formerly independent claims 10 and 29 have been rewritten to depend from claims 1 and 20, respectively. These claims are not anticipated by the Patton patent because the Patton patent does not describe (means for) accepting information read from the unique label identifier associated with a storage medium without reading the storage medium and converting such information into a database key."

Fifth Examiner Response:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., because the Patton patent does not describe (means for) accepting information read from the unique label identifier associated with a storage medium without reading the storage medium and converting such information into a database key) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Sixth Applicant Argument:

Applicant states in the second paragraph on page 19 "Independent claims 15 and 19 are not anticipated by the Patton patent because the Patton patent does not describe (means for) rendering information associated with each of one or more records accepted, the information rendered being related to a label provided on a storage medium without storing it on the storage medium, wherein the storage medium stores one or more files identified with the one or more records accepted."

Sixth Examiner Response:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the Patton patent does not describe (means for) rendering information associated with each of one or more records accepted, the information rendered being related to a label provided on a storage medium without storing it on the storage medium, wherein the storage medium stores one or more files identified with the one or more records accepted) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Seventh Applicant Argument:

Applicant states in the third paragraph of page 20 "The Examiner concedes that the Patton patent ails to teach a bar code label. To compensate for this admitted deficiency of the Patton patent, the examiner contends that (i) the bar code labels are well known in the art, and (ii) that one of ordinary skill in the art would have been motivated top modify the Patton patent to include a bar code label for the purpose of making an automatic entry of information via a handheld scanner."

Applicant states in the fourth paragraph on page 20 "The applicants respectfully disagree with the examiner's conclusion as to motivation to modify."

Seventh Examiner Response:

Examiner is not persuaded. Claim 1 b) (iii) states "writing the unique volume label onto the storage medium." Examiner maintains that Patton discloses above limitation in contrast to applicant's specification. Examiner maintains "writing the unique volume label onto the storage

medium" does not read on applying a bar code label to a jacket which houses a computer readable storage disk.

Other Applicant Arguments:

Applicant on pages 22 and 23 present s further arguments with reference to the specification rather than the claim limitations.

Examiner Responds:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the Patton patent does not describe (means for) rendering information associated with each of one or more records accepted, the information rendered being related to a label provided on a storage medium without storing it on the storage medium, wherein the storage medium stores one or more files identified with the one or more records accepted) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, consider the following excerpt from the MPEP:

MPEP § 2106. II.C Review the Claims:

> Office personnel must rely on the applicant's disclosure to properly determine the meaning of terms used in the claims. *Markman v. Westview Instruments,* 52F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd*, U.S. 116 S. Ct. 1384 (1996). An applicant is entitled to be his or her own lexicographer, and in many instances will provide an explicit definition for certain terms used in the claims. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.,* 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings.").

> Office personnel must always remember to use the perspective of one of ordinary skill in the art. Claims and disclosures are not to be evaluated in a vacuum. If elements of an invention are well-known in the art, the applicant does not have to provide a disclosure that describes those elements. In such a case the elements will be construed as encompassing any and every art-recognized hardware or combination of hardware and software technique for implementing the defined requisite functionalities.
>
> Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris,* 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater,* 415F.2d 1393, 1404-05, 162 USPAQ 541, 550-551 (CCPA 1969). See also *In re Zletz,* 893 F.2d 319, 321-22, 13 USPQ2d 13201322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonable allow ....

Applicant does not particularly point to the specification for an explicit definition of the claim limitations. Examiner thus gives supra claim limitation its broadest reasonable interpretation and maintains that Patton reads on the claimed invention..

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

4/5/2004

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